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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,389	04/20/2001	Daniel C. Castle	10006967-1	2509

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EXAMINER

LAstra, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,389

Applicant(s)

CASTLE, DANIEL C.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 have been examined. Application 09/839,389 (BACKGROUND ADVERTISING IN AN INTERNET ENVIRONMENT) has a filing date 04/20/2001.

Response to Amendment

2. In response to Non Final Rejection filed 10/05/04, the Applicant amended claims 1, 5, 6, 12, 17 and 20. Applicant amendment overcame the Section 101 rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-7, 9, 12 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rashkovskiy (US 6,616,533).

As per claim 1, Rashkovskiy teaches:

A method for displaying advertisements *over the Internet to a computer device* comprising the steps of:

displaying *on the computer device* informational content on a first layer (see figure 8, item 122);

displaying *on the computer device* advertisement content behind the informational content, on a second layer, (see figure 8, items 112, 116, 118, 120, 114)

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such that both the informational content (i.e. information of playing the game, such as moving cars) and the advertisement content are viewable simultaneously (see figure 8) and

displaying on the computer device non-transparent hyper-linked advertisement content on the first layer that is related to the advertisement content on the second layer (see column 5, lines 10-20; figure 8, items 112-120 are clickable background images).

As per claim 2, , Rashkovskiy teaches:

The method of claim 1 and further including the step of displaying both the first and the second layers on a monitor device such that both layers are viewable simultaneously (see figure 8; column 5, lines 10-20).

As per claim 5, , Rashkovskiy teaches:

The method of claim 1 *wherein the advertisement content on the first layer, and the advertisement content on the second layer are related by a common product or service* (see figure 8, items 112-120).

As per claims 6 and 12, Rashkovskiy teaches:

A method for displaying an advertisement over the Internet to a computer device, the method comprising the steps of:

transmitting a first layer, comprising informational content, to a client process (see figure 8, item 122; information about playing a game such a moving car);

and

transmitting a second layer, comprising *hyper-linked* advertisement content, to the client process such that both the informational content and the advertisement content are viewable simultaneously (see figure 8; column 5, lines 10-20) and

transmitting non-transparent hyper-linked advertisement content on the first layer that is related to the advertisement content on the second layer (see figure 8, column 5, lines 10-20).

As per claim 7, Rashkovskiy teaches:

The method of claim 6 and further including the step of the client process requesting delivery of the first and second layers (see column 2, lines 1-20).

As per claim 9, Rashkovskiy teaches:

The method of claim 7 wherein the client process is resident on a personal computer comprising a monitor device (see column 2, lines 20-35).

As per claim 14, Rashkovskiy teaches:

The system of claim 12 wherein the storage media stores information relating to the client process (see column 2, lines 7-50).

As per claim 15, Rashkovskiy teaches:

The system of claim 14 wherein the processor has means for determining an advertisement content from the plurality of advertisement content in response to the information relating to the client process (see column 3, lines 35-50).

As per claim 16, Rashkovskiy teaches:

The system of claim 12 wherein the client process is an automatic content delivery service that requests information content from predetermined Internet resources (see column 3, lines 35-50).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rashkovskiy (U.S. 6,616,533).

As per claims 3, 4 and 8, Rashkovskiy teaches:

The method of claim 1 but fails to teach and further including the step of printing both the first and the second layers on a page such that both layers are viewable simultaneously and printing the first and second layers. However, Official notice is taken that it is old and well known in the computer art to print a image that is displayed in the active area of a computer screen. It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention was made to know that a image consisting of a content with a background advertisement that is displayed in a computer screen would be printed using a computer printer.

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Claims 10, 11, 13 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rashkovskiy (U.S. 6,616,533) in view of Anderson (U.S. 6,532,039).

As per claim 10, Rashkovskiy teaches:

The method of claim 7 but fails to teach and further including the step of the client process requesting a predetermined level of transparency of the second layer. Anderson teaches a system that allows to specify the level of transparency of a background image (see column 8, line 50- column 9, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would adjust the level of transparency of a background advertisement, as taught by Anderson. Adjusting the level of transparency would allow to adjust the contrast between the content image and the background image displayed in the computer screen so both images can be viewed simultaneously.

As per claims 11, 13, 17, 19, 20, 21 and 22 Rashkovskiy teaches:

Combining the advertisement content with the predetermined information content to for a Web page (see figure 8), displaying non-transparent hyper-linked advertisement content that is related to the transparent advertisement content (see Rashkovskiy figure 8, column 5, lines 10-20) but fails to teach and further including the step of the transparency of the advertisement content being adjusted to the predetermined level in response to a composition of the computer device and that first layer and the second layer can be viewed simultaneously. However, Anderson teaches the image display would be adjusted depending upon the display interface (see column 8, lines 42-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the application was made, to know that Rashkovskiy would adjust the level of transparency of a background advertisement depending upon the display interface, as taught by Anderson. This feature would allow that the background image and the foreground image can be viewed simultaneously independently of the type of display.

As per claim 18, Rashkovskiy teaches:

The method of claim 17 wherein the request for predetermined information content is transmitted by the client process (see Rashkovskiy column 10, lines 1-26).

Response to Arguments

5. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

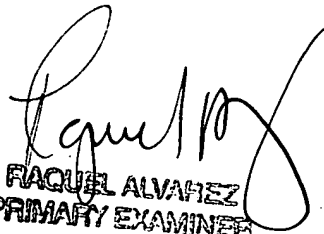
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

The Examiner is scheduled to move to the new Alexandria office in April 2005 (or later). The Alexandria phone number would be 571-272-6720 and RightFax number 571-273-6720. The examiner's supervisor, Eric W. Stamber, new Alexandria number would be 571-272-6724. The current numbers would be in service until the move.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
March 31, 2005


RAQUEL ALVAHEZ
PRIMARY EXAMINER